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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,315	09/05/2003	Asaki Suzuki	788_089 DIV	8216
25191	7590	03/17/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	
DATE MAILED: 03/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,315

Applicant(s)

SUZAKI ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/021,507.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/021,507, filed on October 30, 2001.

Claim Rejections - 35 USC § 112

Claims 1-2, 6, 8 (and dependent claims 3-5, 7, 9-11) rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 6, that part of the claim stating "corresponding to different configurations of said temporary lens" renders the claims vague and indefinite. It is not clear if applicant is successively modifying the same temporary lens and placing the same temporary lens (although modified) onto the eye to obtain the successive optical characteristics or if applicant is placing different temporary lenses i.e. a succession of different temporary lenses with varying degrees of modifying configurations or if the intended meaning is that one can either modify the same temporary lens or use different temporary lenses with varying degrees of modification (the assumed meaning) and the lack of clarity renders the claim vague and indefinite.

With further respect to claims 1 and 6, that part of the claim stating "obtaining successively optical characteristics" renders the claims vague and indefinite. Specifically, it is not clear if applicant is using different configurations of

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the temporary lens and then using each configuration to successively obtain the same optical characteristic as that of the characteristic when the temporary lens was first placed on the eye in the stable position or if applicant is using different configurations of the temporary lens and then using each configuration to successively obtain different optical characteristics each time and the lack of clarity renders the claims vague and indefinite.

With respect to claims 2 and 8, that part of the claim stating “wherein said optical characteristic” renders the claim vague and indefinite. Specifically, as stated in the 112 rejection of the independent claims above, it is not clear if the successively obtained optical characteristics are the same or different from that of the originally obtained optical characteristic and if they are different then it is not clear as to which optical characteristic applicant is referring to by “said optical characteristic” of claims 2 and 8.

With further respect to claim 6, line 10, that part of the claim stating “of said optical system” renders the claim vague and indefinite since it is not clear as to which optical system applicant is referring to. For purposes of examination the assumed meaning is “of said optical system consisting of said temporary lens and said schematic eye” (similar to what is claimed in claim 1).

Claim Objections

Claim 7 is objected to because of the following informality. In lines 5-6, “a radius curvature” should be corrected to “a radius of curvature”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al patent number 6,082,856.

Dunn et al reads on these claims by disclosing the limitations therein including the following: a method for designing an ophthalmic lens (abstract) comprising determining specifications of a temporary lens such that said temporary lens gives optical power required by a wearer (column 11, lines 59-62); applying the temporary lens to a prescribed schematic eye and the schematic eye corresponding to the eye of a wearer (column 11, line 53, column 12, line 1). The temporary lens will inherently be located at a stable position on an eye of a user, this being reasonably based upon Dunn et al disclosing the temporary lens located on the eye of an intended user and an analysis of the eye-lens being performed (column 11, line 53, column 12, line 1); obtaining an optical characteristic of the optical system consisting of the temporary lens and the schematic eye (column 12, lines 1-4 in that if an analysis is being performed

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then the analysis will inherently be obtaining an optical characteristic); obtaining successive optical characteristics corresponding to different configurations of the temporary lens (as this term is understood and column 12, lines 5-16 re varying the shape factor of the temporary lens i.e. "different configurations of the temporary lens"); selecting an optimum one of the different configurations which gives an optimum characteristic (column 12, lines 17-28); determining specifications of an intended ophthalmic lens as a final product based on the selected optimum configuration (column 12, lines 17-28). the optical characteristic will inherently be calculated by one of a wavefront aberration, point spread function, modulation transfer function or resolving power, this being reasonably based upon Dunn et al disclosing performing analysis by tracing the light ray paths through the system.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Seidner patent number 5,493,350.

Seidner reads on these claims by disclosing the limitations therein including the following: a method for designing an ophthalmic lens (column 1, line 13) comprising determining specifications of a temporary lens such that said temporary lens gives optical power required by a wearer (column 2, lines 21-26 i.e. performing an over-refraction of the temporary lens to determine optical power); applying the temporary lens to a prescribed schematic eye and the schematic eye corresponding to the eye of a wearer (column 2, lines 21-59); the temporary lens located at a stable position on an eye of a user (column 2, lines 37-42, column 4, line 62 to column 5, line 5 the optical characteristic as either the

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derived power or posterior surface configuration); obtaining an optical characteristic of the optical system consisting of the temporary lens and the schematic eye (column 2, lines 47-54 i.e. the second over-refraction will inherently obtain an optical characteristic); obtaining successive optical characteristics corresponding to different configurations of the temporary lens (as this term is understood and column 4, lines 38-46 and column 6, line 54 i.e. the plurality of diagnostic lenses will inherently obtain a plurality of successive optical characteristics); selecting an optimum one of the different configurations which gives an optimum characteristic and determining specifications of an intended ophthalmic lens as a final product based on the selected optimum configuration (column 4, lines 38-46, column 2, line 26, column 5, lines 7-30); the optical characteristic calculated by resolving power (column 5, lines 24-30).

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon patent number 6,224,211.

Gordon reads on these claims by disclosing the limitations therein including the following: a method for designing an ophthalmic lens (column 1, lines 4-6, column 2, line 15) comprising determining specifications of a temporary lens such that said temporary lens gives optical power required by a wearer (column 4, lines 44-50); applying the temporary lens to a prescribed schematic eye and the schematic eye corresponding to the eye of a wearer (column 4, lines 47-50). The temporary lens will inherently be located at a stable position on an eye of a user, this being reasonably based upon Gordon disclosing the temporary lens located on the eye of an intended user to obtain emmetropia

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similar to that of the claimed invention (column 4, lines 44-50); effecting emmetropization of the optical system of the schematic eye and the temporary lens (column 4, lines 44-50); obtaining an optical characteristic of the optical system consisting of the temporary lens and the schematic eye (column 4, lines 44-50, the optical characteristic being the optical power to obtain emmetropia); obtaining successive optical characteristics corresponding to different configurations of the temporary lens (as this term is understood and column 2, line 11, column 4, line 43 to column 5, line 35); selecting an optimum one of the different configurations which gives an optimum characteristic (column 5, lines 5-14); determining specifications of an intended ophthalmic lens as a final product based on the selected optimum configuration (column 5, lines 5-14); the optical characteristic calculated by resolving power (column 5, lines 5-14); and emmetropization effected by changing an optical power of the corrective lens (column 4, lines 44-50).

Prior Art Citations

Peterson publication number 2001/0051825 is being cited herein to show a method of designing ophthalmic lenses that would read on claims 1-5, however, such rejections would have been repetitive. Specifically, in paragraph 0010 it states that estimated optical power for the patient is determined to form a temporary lens i.e. determining specifications of a temporary lens to give optical power of a user. Peterson further discloses in paragraph 0011 that successive temporary intraocular lenses are inserted to determine the accurate optical power and thereby determine the final lens. Therefore, the first inserted intraocular lens

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is the “applying a temporary lens to a prescribed schematic eye” and its degree of accurate optical power is the “optical characteristic”. Since it is an IOL it will inherently correspond to a stable position on the eye. The “successive temporary lenses” of paragraph 0011 correspond to the “obtaining successive optical characteristics” and then the optimum temporary lens is selected to determine the final product IOL (paragraph 0011).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

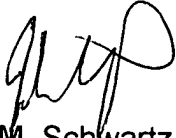
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'JMS', is written over the printed name.

Jordan M. Schwartz

Primary Examiner

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March 3, 2004